

## **REMARKS**

In the Final Office Action mailed on October 1, 2009, all of pending claims 1-6, 9-21 and 26-28 stand rejected. Reconsideration of the pending claims in view of the following remarks is respectfully requested.

### **I. 35 U.S.C. 102 Rejections**

Claims 1-6, 9-15, 18-21 and 26-27 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/47974 (“Heyenk”) or, in the alternative, rendered obvious over Heyenk.

Independent claims 1 and 20 recite a can (claim 1), or a method of making a can (claim 20), in which at least one body or end portion is coated with a coating composition that includes a blend of polyesters including between 60 and 90 weight percent of polyester resin having a T<sub>g</sub> less than about 25°C and between 10 and 40 weight percent of polyester resin having a T<sub>g</sub> greater than 50°C. In contrast, Heyenk exemplifies polymer blends that include a majority of polymer having a T<sub>g</sub> greater than 45°C (i.e., 45-50°C<sup>1</sup>). Heyenk does not disclose a polyester blend that includes between 60 and 90 weight percent of polyester resin having a T<sub>g</sub> less than about 25°C. 37 weight percent is the highest concentration of polyester having a T<sub>g</sub> less than about 25°C disclosed for the Heyenk blend.<sup>2</sup>

In rejecting the claims, the Final Office Action at page 10 asserts that Heyenk “clearly teaches” a blend of polyesters including between 60 and 90 weight percent of polyester resin having a T<sub>g</sub> less than about 25°C because “one of ordinary skill would reasonably infer that the second polymer having a T<sub>g</sub> of less than 10°C would comprise less than 75% of the blend, an amount which anticipates a point within the range claimed by applicant.”<sup>3</sup>

The Final Office Action at page 10 wrongly concludes that Heyenk’s statement that “[t]he weight proportion of the polymer having a T<sub>g</sub> higher than 45°C is generally at least 25%” teaches that polyester material having a T<sub>g</sub> of less than about 25°C necessarily constitutes 75%

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<sup>1</sup> Heyenk does not disclose any polyester materials having a T<sub>g</sub> greater than 50°C.

<sup>2</sup> See Applicants’ Response “B” which includes a table on page 8 showing the T<sub>g</sub>’s and weight percents of the polyesters included in the coating compositions of the Heyenk worked examples. 37 Wt-% corresponds to Example 5.

<sup>3</sup> As stated by the Federal Circuit, for a reference to be anticipatory, “[T]he [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” See *Net Moneyin, Inc., vs. Verisign, Inc.*, \_\_\_\_\_ (Fed. Cir. 2008) slip opinion at page 17, quoting *In re Akley*, 455 F.2d 586, 587 (CCP 1972). Bracketing in original. See also MPEP 2131 which states that in order for a reference to be an anticipatory reference, the elements must be arranged as required in the claims.

of the blend. On the contrary, the other 75% of the blend could include one or more materials other than a polyester polymer having a Tg of less than about 25°C. For example, the other 75% of the blend could include polyester polymers having a Tg greater than about 25°C<sup>4</sup> and/or non-polyester polymers, which is likely given that 37 weight percent is the highest concentration of polyester having a Tg greater than about 25°C disclosed in Heyenk.<sup>5</sup> There is no basis for concluding that Heyenk discloses a polyester blend that necessarily includes between 60 and 90 weight percent of polyester resin having a Tg less than about 25°C.

With regards to the alternate obviousness rejection, the Final Office Action provides no reasoning as to what result(s) a skilled artisan would have sought to achieve in contradicting the preferred teachings of Heyenk and including between 60 and 90 weight percent of polyester resin having a Tg less than about 25°C, let alone why a skilled artisan would have sought to achieve any such result(s) or have had a reasonable expectation of achieving any such result(s).

Furthermore, contrary to the assertions of the Final Office Action, Heyenk does not disclose a polyester blend that also includes between about 10 and 40 weight percent polyester resin having a Tg greater than 50°C. Heyenk does not disclose a single polyester material having a Tg greater than 50°C, let alone provide an enabling disclosure of such a polyester. All of the polyester materials disclosed in Heyenk have a Tg of 50°C or less. Heyenk does not teach any materials or methods for making a polyester having a Tg greater than 50°C that would be suitable for use in the Heyenk coating composition, nor does it teach any such commercially available polyester materials.

In view of the foregoing, it is respectfully submitted that Heyenk neither anticipates, nor renders obvious, any of the pending claims.

## **II. 35 U.S.C. 103 Rejections**

### **A. Heyenk in view of Parekh**

Dependent claims 16 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heyenk in view of U.S. 6,235,102 (“Parekh”). The Final Office Action acknowledges that Heyenk does not disclose the addition of an acrylate copolymer having glycidyl groups and looks to Parekh to overcome this deficiency in Heyenk. However, even *arguendo* if the

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<sup>4</sup> Heyenk discloses that the second polymer has a Tg generally lower than about 40°C, but can have a Tg of 40°C or more. See, e.g., Heyenk at page 2, lines 23-27.

proposed combination were made, the resulting coating composition would not include all of the features of independent claim 1 from which claims 16 and 17 depend.<sup>6</sup> For example, neither reference discloses a composition including a blend of two or more polyesters having between 60 and 90 weight percent of polyester resin having a Tg less than about 25°C. It is accordingly submitted that claims 16 and 17 are allowable over Heyenk and Parekh.

B. Heyenk as evidenced by Parekh in view of Maska

Claim 28 stands rejected as being obvious over Heyenk as evidenced by Parekh in view of U.S. 5,252,669 (“Maska”). The Final Office Action acknowledges that the primary Heyenk reference is silent regarding the use of a phenoplast for cross-linking and looks to Maska to overcome this deficiency. Even *arguendo* if the proposed combination were made, the resulting coating composition would not include all of the features of independent claim 1 from which claims 16 and 17 depend.<sup>7</sup> As discussed above, neither Heyenk nor Parekh discloses a composition including a blend of two or more polyesters having between 60 and 90 weight percent of polyester resin having a Tg less than about 25°C. Maska does not overcome this deficiency in Heyenk and Parekh. It is accordingly submitted that claim 28 is allowable over Heyenk, Parekh, and Maska.

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<sup>5</sup> See Applicants’ Response “B” which includes a table on page 8 showing the Tg’s and weight percents of the polyesters included in the coating compositions of the Heyenk worked examples.

<sup>6</sup> Applicants traverse the assertion that a skilled artisan would have been motivated to make the proposed combination.

<sup>7</sup> Applicants traverse the assertion that a skilled artisan would have been motivated to make the proposed combination.

### **Conclusion**

In view of the foregoing, Applicants respectfully submit that all of pending claims 1-6, 9-21, and 26-28 are in condition for allowance. A notice to that effect is respectfully requested. The Commissioner is authorized to charge any additional fees associated with this paper or credit any overpayment to Deposit Account No. 50-2070.

Respectfully submitted,

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